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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/682,048	10/09/2003	Charles W. Sapp	LEW-01	8158
7590 04/08/2005				
TERRIL G. LEWIS 9507 AUTUMNWAY DR. HOUSTON, TX 77064		EXAMINER PATTERSON, MARIE D		
		ART UNIT PAPER NUMBER		
		3728		

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/682,048

Applicant(s)

SAPP, CHARLES W.

Examiner

Marie Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-10 and 17-22 is/are allowed.
- 6) ☒ Claim(s) 1-5 and 11-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) ☐ Notice of References Cited (PTO-892) | 4) ☐ Interview Summary (PTO-413) |
| 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) ☐ Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) ☐ Other: _____ |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, and 5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hilkemeyer (3040451).

Hilkemeyer shows a cover (10) with slits (13), and a lace (14) which is “placeable over top and side portions of a shoe” in that the cover of Hilkemeyer is clearly capable of being placed over the toe of a shoe and pulled over the top and over the top of the heel portion of the shoe to cover the top of the shoe to prevent dust, dirt, and insects from entering the shoe during storage. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hilkemeyer.

Hilkemeyer discloses a cover (10) with slits (13), and a lace (14) substantially as claimed except for the exact material for the cover. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use plastic, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

5. Claims 1-5 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Despres (5711092).

Despres shows a shoe system comprising a shoe (10) with cleats (shown in figure 12), and a shoe cover (14) with a plurality of pairs of openings (111 shown in figure 13) for passing a lace (110) substantially as claimed except for the exact shape of the openings. Official Notice is taken that slits are a well known and conventional alternative to eyelets and it also is noted that Despres also shown slits as an alternative shape for eyelets. It would have been obvious to shape the openings as slits as is well known and conventional and suggested by Despres to allow a flat type lace to easily fit through the openings.

Allowable Subject Matter

6. Claims 6-10 and 17-22 are allowed.

Response to Arguments

7. Applicant's arguments filed 3/7/05 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards Hilkemeyer, Hilkemeyer shows a cover (10) with slits (13), and a lace (14) which is "placeable over top and side portions of a shoe" in that the cover of Hilkemeyer is clearly capable of being placed over the toe of a shoe and pulled over the top and over the top of the heel portion of the shoe to cover the top of the shoe to prevent dust, dirt, and insects from entering the shoe during storage. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). The claim does not require specific placement on the shoe as in a combination claim it merely requires that the cover be capable of placement over the top of the shoe and the cover of Hilkemeyer is clearly capable of being placed as such.

In response to applicants' arguments directed towards Despres, Despres does shown a cover made of a uniform singular material (only element 14, not including the other elements 12 and 16) which is considered to be "a... flat material" inasmuch as applicant has disclosed such, i.e. applicants' specification page 5 last paragraph recites "can be pressed out from a flat sheet", and in the figures the cover is shown as curved over the shoe. Therefore this limitation has been treated as a product by process limitation and the cover of Despres which is made of uniform material, and thickness is

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clearly capable of having been made from a flat sheet. A comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. In re Fessman, 489 F2d 742, 180 U.S.P.Q. 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. In re Klug, 333 F2d 905, 142 U.S.P.Q. 161 (CCPA 1964). In an ex parte case, product-by-process claims are not construed as being limited to the product formed by the specific process recited. In re Hirao et al., 535 F2d 67, 190 U.S.P.Q. 15, see footnote 3 (CCPA 1976). Also, the term "flat" is defined as "touching at as many points as possible" and the cover of Despres does lie flat against the shoe and therefore is considered to be "flat" inasmuch as applicant has claimed and defined such.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at www.uspto.gov.

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9306 **(FORMAL FAXES ONLY)**. Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.



Marie Patterson
Primary Examiner
Art Unit 3728